REMARKS

The present application was filed on July 25, 2000 with claims 1-25. In this Amendment, Applicants cancel allowable claims 5-10, 12-18 and 20-22. Allowable claims 5-10, 12-18 and 20-22 are being canceled because they are currently pending in Application Serial No. 11/240,605, which was filed as a continuation application.

Since Applicants are filing this Amendment with a Request for Continued Examination (RCE), Applicants also herein present arguments from the previous Appeal Brief and Reply Brief filed in the present application. Applicants request favorable reconsideration of the claims based on the following remarks.

In the final Office Action, the Examiner: (i) rejected claims 1-4 , 24 and 25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,128,633 to Michelman et al. (hereinafter "Michelman") in view of U.S. Patent No. 5,838,819 to Ruedisueli et al. (hereinafter "Ruedisueli); (ii) rejected claim 11 as being unpatentable under 35 U.S.C. §103(a) over Michelman in view of Ruedisueli and further in view of U.S. Patent No. 6,502,114 to Forcier (hereinafter "Forcier") and U.S. Patent No. 5,911,146 to Johari et al. (hereinafter "Johari"); (iii) rejected claim 19 as being unpatentable under 35 U.S.C. 103(a) over Michelman in view of Ruedisueli and in further view of U.S. Patent No. 5,805,118 to Mishra et al. (hereinafter "Mishra"); and (iv) rejected claim 23 as being unpatentable under 35 U.S.C. 103(a) over Michelman in view of Ruedisueli, Forcier and Johari and in further view of U.S. Patent No. 5,909,221 to Nakai et al. (hereinafter "Nakai").

As set forth in Applicants Appeal Brief dated May 8, 2006 regarding the §103(a) rejection of claims 1-4, 24 and 25, Applicants again respectfully assert that the Michelman/Ruedisueli combination fails to establish a proper case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

M.P.E.P. §2143 sets forth three requirements that must be met to establish a proper case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a proper case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, there is a clear lack of motivation to combine the references. For at least this reason, a proper case of obviousness has not been established. Michelman is directed to a method of manipulating page breaks in documents created in accordance with standard word processing and spreadsheet applications such as Microsoft Word and Excel (see columns 1 and 2 of Michelman), while Ruedisueli is directed to a method of processing electronic copies of handwritten notes. That is, the teachings in each reference are directed to completely different environments; one (Michelman) toward standard word processing and spreadsheet applications, the other (Ruedisueli) toward a handwritten note processing environment. Thus, while Ruedisueli is related to a handwriting system, Michelman has nothing to do with a handwriting system. However, other than a very general and conclusory statement in the Office Action, there is nothing in the two references that reasonably suggests why one would actually combine the teachings of these two references.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344.

In the final Office Action at page 3, the Examiner provides the following restatement (i.e., changed from the previous non-final Office Action) to prove motivation to combine Michelman and Ruedisueli, with emphasis supplied: "[i]t would have been obvious to one of ordinary skill at the time of the invention to apply Ruedisueli to Michelman, providing Michelman the benefit of adding [an] electronic notepad as taught by Ruedisueli . . . to the automatic page break pagination . . . ."

Despite the elaboration added by the Examiner in the final Office Action, Applicants submit that this statement is still based on the type of "subjective belief and unknown authority" that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, other than citing disparate portions of each of the references, the Examiner fails to identify any objective evidence of record which supports the proposed combination. That is, there is no objective support given for why one would be motivated to modify techniques (Michelman) that

have nothing to do with a handwriting system to include techniques associated with a handwriting system (Ruedisueli).

Second, Applicants reassert that there is no reasonable expectation of success in achieving the present invention through a combination of Michelman and Ruedisueli. For at least this reason, a proper case of obviousness has not been established. Despite the assertion in the final Office Action, Applicants do not believe that Michelman and Ruedisueli are combinable since it is not clear how one would combine them. That is, how would one implement techniques relating to a handwriting system in a system that does not process handwriting. There was no guidance provided in the previous Office Action, and there is no guidance given in the final Office Action. However, even if combined, for the sake of argument, they would not achieve the techniques of the claimed invention.

Third, Applicants reassert that even if combined, the Michelman/Ruedisueli combination fails to teach or suggest all of the limitations of the claims. For at least this reason, a proper case of obviousness has not been established.

For example, as asserted in Applicants' previous response dated January 12, 2004, the Michelman/Ruedisueli combination fails to teach or suggest "automatically identifying, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page," as in the claimed invention.

For example, as the present specification explains, at page 1, line 15, through page 2, line 2:

> [In accordance with existing techniques,] . . . to maintain . . . accurate correspondence between the physical page and the electronic copy, the writer is required to "turn" the electronic page when changing to a new or previous paper page by pressing the corresponding page-forward or page-backward button on the PDN [personal digital notepad]. These buttons effect synchrony between the physical and electronic page by recording these events in the data stream. Asynchrony between the paper and electronic pages occurs when a writer forgets to press the appropriate button on the device or accidentally presses the button too many times. Subsequent writing is then electronically recorded on the wrong electronic page, and the new electronic ink is recorded on top of the page's original

> electronic ink. This problem may be compounded since the user may flip forward or backward by several pages at a time and may do so several times within a single document. Later, when the resultant electronic page is viewed, the merged original and overwritten electronic ink can be confusing and may be difficult to read and correct.

To address this problem, the claimed invention automatically identifies, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page.

A key aspect with respect to the claimed invention is that the potential page breaks are automatically identified. So, even if a writer forgets to press the appropriate button on the device or accidentally presses the button too many times, causing asynchrony between the paper and electronic pages, the claimed invention automatically identifies, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page.

Michelman has nothing to do with handwriting systems and, therefore, does not address the unique electronic/physical page asynchrony problem associated with handwriting systems. However, while Ruedisueli relates to handwriting systems, it does not address the problem that the claimed invention addresses. That is, while Ruedisueli explains that page identifiers (36) are manually entered in the upper right hand corner of a page to set the page number (column 4, lines 46-56 of Ruedisueli) and to change the page number (column 5, lines 26-40 of Ruedisueli), there is no teaching of automatically identifying, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page, as in the claimed invention.

Thus, while Ruedisueli illustrates a user signaling a page change, the problem is that this manual signaling could be wrong, or the user could just forget to manually signal a page change, resulting in the above-described asynchrony problem. Ruedisueli provides no solutions for this problem. Also, while Michelman mentions allowing a user to select a page break via a graphical user interface and then adjusting the page breaks for the remainder of a document, again, the initial selection is still a manual process, not an automated process. Thus, the cited combination fails to teach or suggest the automated identification operation of the claimed invention.

In the Examiner's Answer mailed on June 14, 2006, the Examiner fails to address all of Applicants' arguments. In addition, the Examiner's Answer raises some new points with which Applicants strongly disagree. Applicants addressed these issues in their Reply Brief dated August 14, 2006. As explained therein, the Examiner's Answer at pages 9-10 states:

> In claim 1, the applicant indicates inserting one or more page breaks in the electronic document and also maintaining page correspondence between an electronic and a physical document in a handwriting system, however, it is unclear weather [sic] the asynchrony of the pages are electronic and physical pages that are related. The claim does not explain what is meant by asynchrony.

As noted above, Applicants argue that the Michelman/Ruedisueli combination fails to teach or suggest "automatically identifying, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page," as in the claimed invention.

Thus, the claim expressly indicates that one or more potential page breaks are automatically identified for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page. Applicants therefore do not understand how it could be asserted that "[t]he claim does not explain what is meant by asynchrony," as is asserted in the Examiner's Answer, since the claim expressly refers to maintaining a page correspondence between the electronic document and a

physical document . . . so as to at least partially reduce asynchrony between an electronic page and a physical page.

The final Office Action, and the Examiner's Answer, fails to address this claim limitation.

Next, the Examiner's Answer at page 10 states:

> It is also well known in the art that word processors as well as hand written pen-based text can be used for text data. It is well known that both environments can be introduced in identifying page breaks.

Applicants are not completely certain of the relevance of this statement. To the degree that the statement is intended to show some motivation to combine Michelman and Ruedisueli, Applicants assert that this is not proper motivation to combine the references, as will be further reiterated below. To the degree that the statement suggests rationale for why the Examiner continues to assert that Ruedisueli teaches the automated identification operation of the claimed invention, Applicants strongly disagree for the reasons given above.

Next, the Examiner's Answer at page 10 states:

> The applicant argues that the prior art does not mention that the potential page breaks are not [sic] automatically identified (Page 7 Para 1-3). However, in Michelman, a system process performs the steps of moving the selected page break to the new location and adjusting the scaling and the automatic page-breaks for the remainder of the document to accommodate the page break at the new location. (Michelman Abstract)

As mentioned above, a key aspect with respect to the claimed invention is that the potential page breaks are automatically identified. Again, even if a writer forgets to press the appropriate button on the device or accidentally presses the button too many times, causing asynchrony between the paper and electronic pages, the claimed invention automatically identifies, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page. This is clearly not the case with Michelman, wherein the Michelman technique operates after the user manually selects a page-break within the electronic document and then manually identifies a new location for the page-break (see Michelman Abstract).

Furthermore, the Examiner's Answer at page 10 states:

> Regarding claims 1, 24 and 25 Applicant argues that there is a lack of motivation as to why Michelman would be combined with Ruedisueli (Page 4 Para 6 and 7). Michelman would be motivated to add to the electronic notepad, which includes devices operatively connected to the electronic notepad for operating with the electronic notepad to receive, manage, merge, and/or display the electronic copies from the electronic notepad as taught by Ruedisueli Abstract Lines 8-12 to automatic page break pagination which performs the steps of moving the selected page break to the new location and adjusting the remainder of the document to accommodate the page-break at the new location as taught by Michelman Col 4 Lines 45-49.

This above statement still fails to support the rationale to combine, since it simply states that something alleged about Michelman could be added to something alleged about Ruedisueli without stating why one would add the two together.

As mentioned above, to the degree that the Examiner's statement at page 10 of the Examiner's Answer ("It is also well known in the art that word processors as well as hand written pen-based text can be used for text data. It is well known that both environments can be introduced in identifying page breaks.") is intended to support motivation to combine the references, Applicants do not see how such a statement serves as objective support for why one would be motivated to modify techniques (Michelman) that have nothing to do with a handwriting system to include techniques associated with a handwriting system (Ruedisueli).

Pages 10 through 13 of the Examiner's Answer with regard to claims 2-4 appear to be nothing other than a further repeat of the rationale offered in the final Office Action and repeated once already at pages 5 through 9 of the Examiner's Answer.

For at least these reasons, it is asserted that independent claims 1-4, 24 and 25 are patentable over Michelman and Ruedisueli.

Regarding the §103(a) rejection of the various dependent claims, Applicants respectfully assert that the various combinations, based on Michelman/Ruedisueli that also include one or more of Forcier, Johari, Nakai and Mishra, also fail to establish proper cases of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143. Such dependent claims are patentable over the cited combinations not only due to their dependence on the above-mentioned independent claims but also because such claims recite patentable subject matter in their own right.

Pages 10 through 13 of the Examiner's Answer with regard to claims 2-4, 11, 19 and 23 appear to be nothing other than a further repeat of the rationale offered in the final Office Action and repeated once already at pages 5 through 9 of the Examiner's Answer.

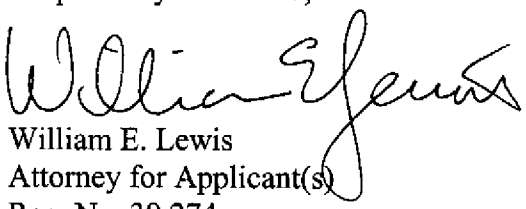
For example, dependent claim 11 recites the step of determining a confidence measure for the potential page break associated with the possible insertion point. However, the rejection relies on Johari which relates to a commercial telephone directory. It is believed that Johari is not properly combinable with Michelman and Ruedisueli since there is no clear support for how or why one would combine such disparate references. Even if combinable, for the sake of argument, the advertisement stream page break is not the same as the claimed feature. Furthermore, the final Office Action makes no mention of Forcier in its rejection rationale.

Further, by way of example, dependent claim 19 recites the step of automatically identifying one or more potential page breaks by utilizing a learning algorithm. However, the rejection relies on Mishra which relates to a display protocol specification with session configuration and multiple monitors. It is believed that Mishra is not properly combinable with Michelman and Ruedisueli since there is no clear support for how or why one would combine such disparate references. Even if combinable, for the sake of argument, just because Mishra mentions a learning algorithm does not mean Mishra discloses the claimed feature.

Still further, by way of example, dependent claim 23 recites the step of identifying a potential page break as a point offset from a possible insertion point determined in accordance with a scoring procedure. However, the rejection relies on Johari which relates to a commercial telephone directory. Again, it is believed that Johari is not properly combinable with Michelman and Ruedisueli since there is no clear support for how or why one would combine such disparate references. Even if combinable, for the sake of argument, any score disclosed in Johari is not the same as the claimed feature. Furthermore, the final Office Action makes no mention of Forcier or Nakai in its rejection rationale.

In view of the above, Applicants believe that claims 1-4, 11, 19 and 23-25 are in condition for allowance, and respectfully request withdrawal of the various §103(a) rejections.

Respectfully submitted,



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